

REMARKS

The Office Action mailed on July 02, 2003, has been reviewed and the comments of the Patent and Trademark Office have been considered. Prior to this paper, claims 1-3, 7-12 and 21-22 were pending. Claims 7 and 12 have been amended. No claims have been added or deleted. Thus, claims 1-3, 7-12 and 21-22 remain pending in the present application.

Claim Rejections Under 35 U.S.C. §102(b)

In the Office Action, Independent claims 7 and its dependent claims 10, 11 and 21 (now independent claim 21) are rejected under 35 U.S.C. §102(b) as being anticipated by Schulte (USP 4,565,597). In response, Applicants have amended claims 7 and 21 (claim 21 is simply placed in independent form, and does not include the limitations added to claim 7 in this amendment) as seen above, and submit that these claims are allowable in view of MPEP §2131, which states that a “claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

Claim 21:

Claim 21, now in independent form, recites the limitation that the individual joined veneers have only **a single seam normal** to the direction of cutting. An example of individual joined veneers having only a single seam may be seen in Fig. 3 of the specification. Schulte does not teach such a limitation. To the contrary, each and every example of Schulte teaches a veneer board that has a plurality of seams along the direction of cutting.

The Office Action alleges that Schulte discloses a method “in which the individual joined veneers can be produced to have only one seam,” citing Fig. 4 of Schulte. Applicants respectfully submit that Schulte does not teach such a recitation. Thus, the limitation of claim 21 is not met by Schulte, and the requirements of MPEP §2131 are not met in the Office Action. Claim 21 is therefore allowable. **If the PTO intends to maintain the rejection of claim 21 in view of Schulte, Applicants respectfully request that the PTO identify the individual joined veneer of Schulte in Fig. 4 that is believed to have only a single seam.**

Claim 7:

Claim 7 now recites that “a width in the direction across the grain of an oncoming first veneer is *different* than the width in the direction across the grain of an oncoming second veneer.”¹ That is, as is detailed by example on page 3, lines 18-31 of the specification, the widths of the individual veneers are different due to the starting veneer’s width tolerance of about ± 25 mm on the supply stack 2. This results in the advantage that the gaps “e” formed by the junction points “d” are “distributed across the entire board and no longer constitute a weak point.” (Specification, page 3, lines 23-24.)

In stark contrast, Schulte states that “the peeled veneer is cut to strips of *equal width*.” (Schulte, abstract, emphasis added.) The equal width of the strips of Schulte is fundamental to Schulte’s process (and thus not mere design choice), as it states in the specification that “[i]n accordance with the invention, veneer web 5 as well as the separate portions thereof are cut to individual strips of *equal width* corresponding to the spacing of lines 3 [(see Fig. 1A)], the cuts extending substantially parallel to the fiber direction.” The importance of the equality of the widths of the strips is further seen in the independent claim of Schulte, which includes the limitation that the veneer is divided “into strips of *equal width*.” (Schulte, claim 1, emphasis added.)

In sum, claim 7 is allowable for at least the reason that Schulte does not teach the limitation that the widths of the veneers are different. Reconsideration and allowance of claim 7 is respectfully requested.

Claim Rejections Under 35 U.S.C. §103(a)

In the Office Action, independent claims 1 and 22, and formerly dependent claim 12 (now independent claim 12) are rejected under 35 U.S.C. §103(a) as being unpatentable over Schulte alone or in combination with Bielfeldt (USP 5,895,546). Applicants respectfully traverse the rejection as to the claims above, and submit that these claims are allowable for at least the following reasons.

¹ Claim 7 is also amended to change the phrase “width b” to “dimension b,” so as to establish uniform terminology with respect to the direction of the grain of the veneers.

Applicants rely on MPEP § 2143, which states that:

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

It is respectfully submitted that at least the first and third criteria of MPEP § 2143 have not been met in the Office Action as to claims 1, 12 and 22.

Claim 12:

Claim 12 stands rejected as being obvious in view of Schulte. The Office Action admits “that Schulte is silent as to *a method* in which the individual extra-wide joined veneers are cut off such that the seams are *distributed irregularly* over the width of the individual extra-wide joined veneers” (emphasis added), but alleges that the cutting device disclosed by Schulte can be used to practice the claimed method.

First, Applicants submit that the present invention is not obvious because there is a lack of suggestion or motivation to modify Schulte. MPEP § 2143.01 states that “the prior art ***must*** suggest the desirability of the invention.” (MPEP § 2143.01, subsection 1, emphasis added.) MPEP § 2143.01 further states that obviousness

can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. ‘The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.’

(Citations omitted.)

The Office Action **does not** identify where the prior art suggests the desirability of the claimed invention. Indeed, the Office Action does not even allege that modification of Schulte would be desirable. Instead, the Office Action correctly states that “Schulte is silent” about the required limitation. The MPEP specifically states that the “mere fact that references can be combined or modified does **not** render the resultant combination obvious unless the prior art **also suggests the desirability** of the combination.” (MPEP § 2143.01, subsection 3, first sentence, citations omitted.) Applicants respectfully submit that a reference’s silence does not satisfy the statute. Thus, claim 12 is allowable in view of Schulte for at least this reason, but there is more.

Second, the rejection of claim 12 in view of the apparatus of Schulte does not comport with, and is, in fact, **directly contradictory to**, the Restriction Requirement issued July 01, 2002 by the PTO, which effectively asserted that the as-filed method claims and apparatus claims (withdrawn and later cancelled) are patentably distinct from one another. That is, by demanding that Applicants restrict their invention to either a method or an apparatus for practicing the method, the PTO has conceded that even if an apparatus for practicing the various methods of the present invention existed in the prior art, the method is patentable over such a prior art apparatus. To now assert that the method claims are obvious in view of an apparatus that fails to teach claimed limitations, as is proffered in the present Office Action, is contrary to the restriction requirement. Applicants submit that the restriction requirement between the method and apparatus claims provides yet further evidence of the non-obviousness of the present invention in view of Schulte for this additional reason. Reconsideration of the rejection of claim 12 is respectfully requested.

Claims 1 and 22:

Claims 1 and 22 stand rejected as being obvious over Schulte when combined with Bielfeldt. However, even after combining Schulte with Bielfeldt, each of the limitations of claims 1 and 22 are still not present in the cited references.

For example, combining the two references to practice the present invention (assuming *arguendo* that it would have been obvious to combine the references) would still

not result in the production of LVL where the individual extra-wide joined veneers are orientated in the LVL such that the abutting edges are **not aligned** with each other and are **irregularly distributed** in a cross-section of the LVL. (An exemplary LVL produced according to the methods of claim 1 or 22 can be seen in Fig. 3 of the specification.)

By **requiring** that the strips used to make the veneer sheets 17 are of an equal width (as discussed above), Schulte teaches that the resulting veneer sheets 17 are of a configuration such that the seams formed by the attachment of the strips along the length of the strips **align** with one another if the produced veneer sheets 17 were utilized by the apparatus taught in Bielfeldt, in contrast to the above identified limitation. Thus, at least one limitation of claim 1 and claim 22 is not found in the cited references, either alone or after combination, and thus a *prima facie* case of obviousness has not been established.

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Further, the combination of Schulte and Bielfeldt proffered in the Office Action against claims 1 and 22 does not satisfy the requirement of 35 U.S.C. § 103(a) that the prior art must render obvious the “subject matter as a whole” of the claimed invention. This includes any advantages flowing from the claimed invention.

Assuming *arguendo* that each limitation of claims 1 and 22 is present in the combined references (which, as shown above, it is not), claims 1 and 22 would not have been obvious because such a combination of references would still not result in the advantages of the recited inventions. For example, an advantage of the cited inventions is that the individual veneers that abut one another may abut one another without trimming the abutting edges of the individual veneers or with minimal trimming of the abutting edges. That is, individual veneers with rough edges and/or individual veneers with edges that are not parallel to adjacent edges of an abutting individual veneer may be used to produce the extra-wide joined veneer. This has the advantage of reducing veneer “scrap” (less trim loss), reducing the number of manufacturing steps, reducing the number of cutting operations (increasing safety and decreasing the requirement to replace consumable components (such as the cutter)), etc., resulting in an overall increase in efficiency and economic operation of an LVL plant.

Indeed, because additional cutting machines are not required, the present invention also permits the production of extra wide LVL with **decreased capital costs** required to produce a given quantity of LVL, as fewer machines are necessary to produce LVL. In contrast, as is repeatedly stated in Schulte, the abutting edges are trimmed and parallel to one another. Thus, utilizing the boards of Schulte in Bielfeldt will not result in the economic advantages of the recited inventions recited in claims 1 and 22..

Also, because the methods of claims 1 and 22 permit the use of individual veneer boards of different sizes, the gaps “e” formed by the junction points “d” are advantageously distributed across the entire board and no longer constitute a weak point, as is discussed above.

In sum, even if each limitation of the claims were present in the cited references after combination, it would not have been obvious to the ordinary artisan to combine the references to achieve claims 1 and 22. Reconsideration is respectfully requested.

Remaining Rejections under 35 U.S.C. §§102-03

As can be seen above, claims 1, 7 and 22 are allowable. As such, the claims that depend from any of these claims are allowable as well. Reconsideration is respectfully requested.

The Above Amendments to the Claims Should be Entered

Applicants note that the Office Action states that there are “new grounds of rejection” in this case. Therefore, Applicants respectfully submit that the amendments should be entered so that Applicants have a chance to sufficiently address these “new grounds of rejection” via amendment of the claims. Further, Applicants note that independent claims 12, 21 and 22 contain the same limitations as were contained in those claims prior to the filing of this paper (amendments to claims 12 and 21 relate only to placing the claims into independent form and changing the phrase “width b” to “dimension b”). Thus, as the rejection of these claims is not supported by the statute. Therefore, prosecution of these claims should continue

unless the claims are allowed in the next paper issued by the PTO. As to the amendment to claim 7, the amendment places the claim into better condition for allowance, and simply clarifies the terminology of the claim by reciting that the boards are of different widths. Entry of the above claim amendments is respectfully requested.

Conclusion

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Examiner Hawkins is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date

mlc
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By



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